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OFFICE OF PETITIONS

In re Application of
Kamal Acharya et al.
Application No. 09/975,831
Filed: October 11, 2001
Attorney Docket No: 320529527US

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ON PETITION

This is a decision on the petition filed April 27, 2010 under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.131 where it requires that an affidavit be executed by the named inventors.

The petition under 37 CFR 1.183 is **GRANTED**.

The above-identified application was filed on October 11, 2001 with an Oath fully executed by all of the co-inventors. In response to a Final Office Action mailed October 27, 2009, which set a shortened statutory period for reply of three months, applicant submitted a reply, a declaration under 37 CFR 1.131 and a three month extension of time. The 37 CFR 1.131 declaration stated that all of the inventors were responsible for reduction to practice of the subject matter of the rejected claims prior to the date of the reference on which the October 27, 2009 rejection was based. However, the 37 CFR 1.131 declaration was signed by all joint inventors except joint inventors Peter Gremett, Vincent Tong, Ellen F. Butler and Matthew Crampton. Applicant has filed the instant petition to have the 37 CFR 1.131 declaration entered despite the fact that the declaration was not signed by joint inventors Gremett, Tong, Butler and Crampton. According to applicant, joint inventors Gremett, Tong, Butler and Crampton are unavailable or could not be located.

37 CFR 1.131 states, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the **inventor** of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.¹

In addition, the Manual of Patent Examining Procedure states that "an application or

¹ 37 CFR 1.131(a) (emphasis added).

declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection."²

Here, there has not been a party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, the instant application is not the subject of a patent under reexamination. Moreover, it has not been shown that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the only party eligible to sign the 37 CFR 1.131 declaration are all of the joint inventors including joint inventors Gremett, Tong, Butler and Crampton.

The petition bears proof that efforts to locate joint inventors Gremett, Tong, Butler and Crampton, such as internet searches, were used to locate them, but to no avail.

In order for a petition under 37 CFR 1.183 to be granted, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

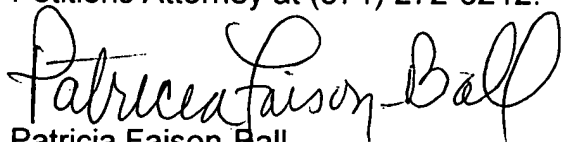
The 37 CFR 1.131 declaration was required to be signed by all joint inventors but all except joint inventors Gremett, Tong, Butler and Crampton have executed it. Applicant has demonstrated that a *bona fide* effort was made to locate joint inventors Gremett, Tong, Butler and Crampton. Accordingly, it is concluded that petitioner has demonstrated that this is an extraordinary situation requiring waiver of the rules.

The 37 CFR 1.131 declaration will be entered, despite the fact that its requirement that all of the inventors sign the declaration has not been satisfied.

Petitioner is advised that the fee for a petition under 37 CFR 1.183 is set at \$400 not \$200 thus, petitioner's deposit account no. 50-0664 has been charged in the amount of \$200 per the authorization included with the petition, to supplement the \$200 submitted via electronic transfer.

The application file is being forwarded to Technology Center 3625 for consideration of the reply and the 37 CFR 1.131 declaration, filed April 27, 2010.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
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² MPEP 715.04.